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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/658,651   | 09/09/2003  | Mark A. Reiley       | 10002-701.410       | 1980             |
| Joe Basista<br>Facet Solutions, Inc.<br>45 South Street<br>Hopkinton, MA 01748 |             |                      |                     |                  |
| 7590 10/05/2010  |             |                      |                     |                  |
| EXAMINER   |             |                      |                     |                  |
| PRONE, CHRISTOPHER D   |             |                      |                     |                  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
| 3738   |             |                      |                     |                  |
| MAIL DATE  |             | DELIVERY MODE        |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/658,651

**Applicant(s)**

REILEY, MARK A.

**Examiner**

CHRISTOPHER D. PRONE

**Art Unit**

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 27, 28, 30-34 and 39-46 is/are pending in the application.
- 4a) Of the above claim(s) 39-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 27, 28 and 30-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB06)  
Paper No(s)/Mail Date See Continuation Sheet
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ ~~Notes of Informal Patent Application~~
- 6) ☐ Other: \_\_\_\_\_

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :9/9/03,12/21/09, 11/3/04, 11/4/04, 3/8/05, 6/20/05, 8/24/05 7/28/06.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/21/09 has been entered.

### ***Status of Claims***

Claims 1, 27, 28, 30-34, and 39-46 are pending.

Claims 39-46 are withdrawn.

Claims 2-26, 29, and 39-46 are cancelled.

### ***Specification***

The abstract of the disclosure is objected to because it contains more than the allotted word limit. The current abstract contains 162 words which is 12 over the limit. Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 48 refers to “a selected prosthetic material” but fails to define the group of materials. It is unclear what the material is selected from.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 27, and 30-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith USPN 5,092,893.

Smith discloses the invention substantially as claimed being a spinal prosthesis system comprising Caudal prosthesis having a pair of pedicle anchors 15 comprising facet joint structure capable of being attached to a inferior vertebral body, a Cephalad prosthesis having a pair of pedicle anchors 15 comprising facet joint structure capable of being attached to a superior vertebral body, a plurality of bearing surfaces shown best in figure 7, and an artificial joint connecting the structures shown best in figures 1 and 2. Smith further discloses that the facet joint structures comprise stems and

screws. The examiner is interpreting the threaded lock connections shown in figure 7 of Smith to be means to resist rotation.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 28, 33, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith USPN 5,092,893.

Smith discloses the invention substantially as claimed being described supra. However, Smith does not disclose that the material for making the implant or that the artificial facet joints are attached by adhesive or cement.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the connections of Smith with any of the known equivalents within the art including adhesive or cement in order to please the operator's preference or to accommodate different characteristics of the implant site. These connections are all well known options that would be interchangeable to one of ordinary skill in the art at the time of invention. See Wall USPN 4,502,161, for example of a bone implant teaching that adhesives and mechanical fasteners are interchangeable.

In regards to claim 28, it would have been obvious to make the implant of Smith out of the listed materials. The implant materials are well known within the art. For

example, see Zang 5,314,486 wherein the prosthesis is fabricated from selected biocompatible materials including titanium, cobalt chrome and may be fastened to the bone by with roughen surface providing a bone in-growth surface medium.

In regards to claim 34, it would have been obvious to include bone growth material within the implant of Smith in order to decrease the healing time. Implant with bone growth materials are well known within the art. For example, see Burton USPN 5,282,863.

### ***Response to Arguments***

Applicant's arguments with respect to all claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER D. PRONE whose telephone number is (571)272-6085. The examiner can normally be reached on Monday through Fri 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher D Prone  
Examiner  
Art Unit 3738

/Christopher D Prone/

/Corrine M McDermott/

Supervisory Patent Examiner, Art Unit 3738